

REMARKS

35 U.S.C. § 103 Rejection

The Office action rejects claims 1-3, 6 and 91-97 (all pending claims) under 35 U.S.C. § 103(a) as being obvious based on U.S. Patent No. 6,511,377 ("Weiss"). Although Applicants respectfully disagree with the rejections, they have nonetheless amended claims 1, 91 and 93-94 for further clarification.

Most of the amendments in the present response are intended to clarify that the start or end of a regular or virtual gaming session occurs in response to "an insertion" of a player card, "a removal" (or "a second removal") of a player card, "a re-insertion" of a player card, "a completion" of a game, or "an entry" of value. These amendments make it clear that gaming sessions start and/or end in response to events, rather than in response to a particular state of a gaming machine or player card. For example, it is the event of inserting a card that triggers the end of the first virtual gaming session and the start of the first regular gaming session in claim 1, rather than the card's state of being inserted. The amendments do not add new matter, as Applicants' original specification shows and describes the events of insertion/removal/re-insertion/completing/entry as triggering the start or end of a regular or virtual gaming session. *See e.g.* Application at Figs. 4A-4C and ¶¶ 67-69, 73-74.

The remaining amendments clarify that collected activity data corresponds to "player" activity on a gaming machine "that occurred" during a (virtual or regular) gaming session. These amendments serve to even more definitively rule out an interpretation, for example, whereby a "time out" period with no player activity could constitute a virtual gaming session during which player activity is tracked. The amendments do not add new matter, as Applicants' original

specification clearly refers to player activity occurring during virtual gaming sessions. *See e.g. id.* at Fig. 3 and ¶¶ 81-97.

Especially in light of the above amendments, Applicants believe that the claimed inventions are very clearly distinguished from, and are nonobvious over, the Weiss reference. Generally, Applicants' claims are directed to the tracking of a player's gaming activity that occurs before and/or after a regular gaming session (i.e., at times when the player's card has not yet been inserted and/or at times when the player's card has been removed). *See id.* at ¶¶ 11-13. In the present application, "tracking" is claimed in terms of collecting activity data (corresponding to player activity on a gaming machine during a gaming session), transmitting that activity data to the central authority, and storing in that same player's account information that is based on the activity data. Failing to properly track a player's gaming activity that occurs during those times can be problematic:

Without proper tracking, players lose points they might normally receive or gain more points than they might normally receive. In addition, casinos use player tracking information as valuable marketing information. Such marketing information may be misleading or lost to the casino if players cannot be properly tracked.

Id. at ¶ 7.

In prior art gaming systems, however, "player points and statistics are not accrued for a game player who does not have his or her player card inserted into the gaming machine." *Id.* at ¶ 5. This is also true of Weiss, which only discloses transferring credits to a player's account in situations where either (1) the player's card is still in the reader and the player enters his PIN number (see Weiss at 19:8-14), or (2) a "time out" period with no gaming activity elapses after credits had previously been accrued (see Weiss at 19:1-7). With respect to the time out period,

Weiss teaches a transfer of credits to the player account, but nowhere discloses or suggests that the transferred credits were accrued based on player activity occurring before insertion or after removal of the player's card. To the contrary, Weiss only contemplates credits being tracked in a particular player's account based on player activity that occurred while that player's card was inserted in the gaming machine reader. *See e.g.* Weiss at Figs. 6-8 (depicting a continuous flow of steps from figure to figure, where the player card is inserted in Figure 6, credits are accrued in Figure 7, then the player card is removed in Figure 8). Weiss additionally describes the situation in which "the player removes his card without transferring credits to his account," where the remaining credits "are subject to play independent of the player card." *Id.* at 19:19-21 (emphasis added). As is self-evident from that statement, no credits are tracked in that situation (again, where "tracking" is understood to include transferring those credits to the player's account).

In each of these situations, therefore, Weiss fails to teach the tracking of points or other information corresponding to player activity that occurs outside of the player's regular gaming session. As noted in the Office action, Weiss does include the statement that "[t]ypically, the cashless gaming system tracks all player activity[.]" *Id.* at 3:50-51; *see also id.* at 4:41-42 ("An on-line gaming information system with a player tracking module allows all player activity to be monitored[.]"). These general statements, however, do not specify exactly what information is tracked, or how it is tracked. The statements appear simply to refer to the well-known tracking of player activity that occurs during a regular gaming session when the player's card is inserted, and a person of ordinary skill in the art would have interpreted it as such. To expand the meaning of the general statements in Weiss to specifically include full tracking of gaming activity that occurs when a player's card is not inserted would constitute improper hindsight

based on Applicants' specification. As stated in the MPEP:

In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP 2142 (emphasis added).

But even if these statements of Weiss are interpreted as meaning that player activity occurring outside a regular gaming session is also tracked, the disclosure of Weiss is not enabling. See MPEP at 2121.01 ("The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter[.]"). Weiss in no way describes how it is that "all" player activity (including activity occurring before or after the player's card is inserted) is tracked. More specifically, Weiss does not describe or even suggest how its game system manages to (at "all" times) associate a player's activity with that player's account, even if the player's activity occurs while the player's card is not inserted.

Applicants now address the arguments presented in the November 4, 2008 Office action in turn:

With respect to claims 1, 91 and 93-94, the Office action states that Weiss discloses "identifying an end of the first regular gaming session associated with the player account, wherein said end of the first regular gaming session occurs in response to an indication that the player card is removed from the one gaming machine" at Figure 7, at the step entitled "Player Finishes Playing Gaming Machine." Office action at 4. Even without the present amendments,

Applicants respectfully disagree with this statement. Figure 7 of Weiss does not show that the player card is or has been removed at the cited step of "Player Finishes Playing Gaming Machine." Figures 6-8 represent a single, continuous flow of steps, as indicated by the reference letters "A" through "C" at the top and/or bottom of each figure. Thus, the bottom of Figure 6 continues at the top of Figure 7, and the bottom of Figure 7 continues at the top of Figure 8. As shown, the step of "Player Removes Card" (or, in an alternate path, "Card Removed Without Transferring Credits To Account") does not occur until Figure 8, several steps after the step of finishing game play.

The Office action also states that Weiss discloses "identifying a start of a first virtual gaming session associated with the player account, wherein said start of the first virtual gaming session occurs in response to an indication that value is entered on the gaming machine." Office action at 4. More specifically, the action states:

Weiss teaches of virtual gaming sessions under three conditions a) when there are credits but a period of inactivity on the machine (Col. 19 Lines 1-7), b) when there are credits but the card is left in the machine and no PIN is entered (Col. 19 Lines 8-18) and c) when there are credits on the machine but the player does not transfer the credits to his account (Col. 19 Lines 19-21). In any case, giving the claim the broadest reasonable interpretation these credits are still associated with the player who earned them, they are just unclaimed. Weiss discloses "[t]ypically, the cashless gaming system tracks all player activity" (Col. 3 Lines 50-54; Col. 4 Lines 41-44) such that it is reasonable to infer that once activity is associated with an account it is tracked so that it can be applied to the account when claimed to inter alia further an object of the present invention "to provide a system as characterized above which includes real-time accounting means communicating with both the card reading means and the player's card to enable any particular gaming machine for game play to immediately update status as a function of player wagering activity[.]"

Id. at 4-5. For the reasons described hereafter, none of the three conditions cited in the above statement (conditions "a" through "c") correspond to the amended limitations of independent claim

1 (directed to a virtual gaming session occurring prior to a regular gaming session) or independent claim 93 (directed to a virtual gaming session occurring after a regular gaming session).

Claim 1 requires that the “start of the first virtual gaming session occurs in response to an entry of value on the one gaming machine.” While each of conditions “a,” “b” and “c” does require that “there are credits” available, none describe a session or time period that begins in response to an entry of those credits. Moreover, the first virtual gaming session of claim 1 occurs before the first regular gaming session (which necessarily follows from the fact that claim 1 also requires that the “end of the first virtual gaming session occurs before the start of the first regular gaming session”). Conditions “a” through “c” of Weiss, on the other hand, all refer to time periods that occur during or after the regular gaming session (i.e. when the player card is still inserted, or after the player card is removed).

Claim 93 requires that the “start of said first virtual gaming session occurs:

- (i) after the end of the first regular gaming session; and
- (ii) in response to an indication that the removal of the player card from the one gaming machine occurred while a game was in progress on the one gaming machine, while credits were available for play on the one gaming machine, or both.”

Neither condition “a” nor “b” of Weiss describes a time period that starts in response to an indication that the removal of the player card occurred while a game was in progress, while credits were available for play, or both. Condition “c” does describe a period of time that starts when a card is removed and credits are available for play, but Weiss explicitly states that those credits are not transferred to the player’s account (thus failing to disclose the later limitation in claim 93 of “storing in the player account of the database information based on the first activity

data and the second activity data”).

Next, the Office action states that Weiss discloses “identifying an end of the first virtual gaming session associated with the player account, wherein said end of the first virtual gaming session occurs before the start of the first regular gaming session and in response to the indication that the player card is inserted into the one gaming machine” at 19:1-21 (“wherein play may continue on the gaming machine using said remaining credits until the account balance is depleted or until a pre-determined timeout session occurs”), and at Figure 6 (at the step entitled “Insert Card into Card Reader at Slot Machine”) and 7:25-26 (wherein “Next, the player approaches any gaming machine Gn and inserts the player card into the card reader 82 . . .”).

These portions of Weiss do not disclose the cited limitation (as amended) in claim 1. Neither the “time out” period of 19:1-7, the “abandoned card” scenario of 19:8-18, nor the removal of a card without transferring credits in 19:19-21 teaches ending a virtual gaming session in response to an insertion of the player card into the gaming machine. Although portions of Weiss (Figure 6 and 7:25-26) do disclose the insertion of a player card into a gaming machine, Weiss does not teach that the referenced card insertion triggers the end of any virtual gaming session. Weiss therefore fails to disclose the end of the virtual gaming session as claimed in independent claim 1.

Moreover, Applicants note that the Office action omits any discussion of the limitations concerning the end of the virtual gaming session in independent claim 93. Amended claim 93 requires that the “end of the first virtual gaming session occurs in response to one or more of:

- (i) a completion of a game on the one gaming machine;
- (ii) an indication that no credits are available for play on the one gaming machine; and

(iii) a re-insertion of the player card into the one gaming machine.”

Weiss does not teach ending a virtual gaming session in response to one or more of these three triggers, where the virtual gaming session began as required by claim 93, and where information based on activity data that corresponds to player activity that occurred during the virtual gaming session is stored in the player’s account.

The Office action does admit that “Weiss does not automatically associate the value on the gaming machine with a player account without a PIN number.” Office action at 5-6. However, the action finds that “Applicant has merely automated associating virtual gaming sessions with a player in only those cases of condition b) and c) (above).” *Id.* at 6. According to the action, Applicants’ claimed invention merely “eliminates the manual PIN entry” required in Weiss. *Id.*

Applicants again must respectfully disagree. As an initial matter, Applicants’ claimed inventions and the cited portions of Weiss have different functions and lead to different results. An obviousness rejection cannot be properly based on “mere automation” of a reference where the reference produces a different result. *See* MPEP 2144.04, Part III (“[B]roadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” (citing *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)) (emphasis added)). Applicants’ claimed inventions serve to “provide a gaming system in which a player’s gaming activity is tracked during a virtual gaming session at an individual gaming machine,” thereby providing “game activity tracking both prior to card insertion and after card removal.” Application at ¶¶ 11-12 (emphasis added). Conversely, the disclosed features of Weiss do not result, either explicitly or inherently, in the

tracking of player activity that occurs during a virtual gaming session (i.e., player activity that occurs before insertion or after removal of the player's card). Given the different functions and results of Applicants' claimed inventions and Weiss, it cannot be said that the former merely automates the latter.

Moreover, the manual PIN entry referred to in the Office action (and found at 19:10-13 of Weiss) only allows a player to claim credits for his or her account when condition "b" occurs (i.e., only when that "player's card is left in the machine G_N and there are credits on the credit meter" (emphasis added)). Conversely, Applicants' claimed inventions require the tracking of player activity that occurs before the player's card is inserted and/or after the player's card is removed. Therefore, the claimed inventions do not "merely automate" the process of condition "b" in Weiss. With respect to condition "a" (time out period), Weiss teaches automatic transferring of credits to a player account, but does not teach that those transferred credits were earned based on player activity that occurred outside of a regular gaming session. *See* Weiss at 19:1-7. Conversely, amended claims 1 and 93 each require that "said second activity data corresponds to player activity on the one gaming machine that occurred during the first virtual gaming session." And with respect to condition "c," Weiss does not teach tracking credits at all—rather, "credits are subject to play independent of the player card" when "the player removes his player card without transferring credits." *See id.* at 19:19-21. Thus, Applicants' claimed inventions do not "merely automate" any of conditions "a" through "c" in Weiss.

For at least the reasons given above, Applicants submit that independent claims 1 and 93 are allowable over the art of record. Claims 2-3, 6, 91-92 and 94-97 are dependent from claim 1 or 93 either directly or indirectly, and thus are allowable over the art of record for at least the

Application No. 10/720,931
Amendment dated February 4, 2009
In response to Office Action dated November 4, 2008

same reasons that claim 1 or 93 is allowable.

Application No. 10/720,931
Amendment dated February 4, 2009
In response to Office Action dated November 4, 2008

CONCLUSION

In view of the above, reconsideration of this application is respectfully requested. Applicants believe that claims 1-3, 6 and 91-97 are allowable over the art of record, and a Notice of Allowance is respectfully solicited.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited and encouraged to contact the Applicants at the number below.

Although no fees are believed to be due at this time, the Commissioner is authorized to charge any necessary fees (or credit any overpayment) to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,
MCANDREWS, HELD & MALLOY, LTD.

Dated: February 4, 2009

/Lawrence M. Jarvis/
Lawrence M. Jarvis
Reg. No. 27,341

McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

Telephone: (312) 775-8000
Facsimile: (312) 775-8100